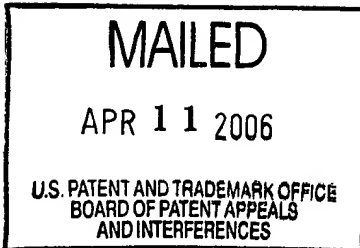


UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
\_\_\_\_\_

Ex parte ROBERT H. SCHEER  
\_\_\_\_\_

Application 09/867,068  
\_\_\_\_\_

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER  
\_\_\_\_\_

This application was received electronically at the Board of Patent Appeals and Interferences on March 31, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the Image File Wrapper (IFW) indicates that appellants filed a Terminal Disclaimer on June 27, 2005. On September 21, 2005, the Final Rejection stated:

The Provisional Double Patenting rejection of Claims 1-22 over Claims 1-19 in the copending Application No. 09/867,301 are withdrawn in response to the terminal disclaimer filed on

Application 09/867,068

June 27, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 09/867,301. The terminal disclaimer has been reviewed and is accepted.

Section 1490 of the Manual of Patent Examining Procedure (MPEP) (Eighth Ed., Rev. 2, May 2004) states:

Where a terminal disclaimer is filed in an application pending in a TC, it will be processed by the paralegal of the Office of the Special Program Examiner of the TC having responsibility for the application. The paralegal will:

. . . . .

(D) Where the terminal disclaimer is acceptable, record the terminal disclaimer in the record of the application as set forth below.

. . . . .

The paralegal will record a terminal disclaimer as being present in an application by:

. . . . .

For applications with 09/ and later series code

A. Checking a box on the file wrapper which states that the terminal disclaimer has been filed.

. . . . .

C. Entering the terminal disclaimer into the PALM system records for the application.

There does not appear to be an entry in PALM regarding the acceptance of the Terminal Disclaimer, nor does anything regarding this acceptance appear in the IFW.

In addition, a five page Information Disclosure Statement (IDS) was filed on September 25, 2001. While the first four pages and the first entry appearing on page 5 of the IDS reflect that the examiner considered the IDS, it is not apparent from the record whether the remaining three non-patent literature documents appearing on page 5 have been considered. Clarification is required.

Finally, on June 27, 2005, appellants filed an amendment to claims 1 and 12. It is noted that the language of claims 1 and 12 in the Appendix to the Appeal Brief differs from its last amended version. 37 CFR § 41.37 (2005) requires that the Appendix to the Appeal Brief contain a correct copy of the claims involved in the appeal. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the  
Examiner:

1) for proper processing of the Terminal Disclaimer  
filed June 27, 2005 in PALM, and to have a copy of the Terminal  
Disclaimer acceptance scanned into the IFW;

2) for consideration of the final three non-patent  
literature documents appearing on page 5 of the IDS filed  
September 25, 2001 and appropriate written notification to  
appellants regarding the Primary Examiner's decision;

3) for notification to appellant to submit a corrected  
Appendix to replace the existing defective Appendix, or for the  
examiner to issue a revised Examiner's Answer to officially  
correct the Appendix;

4) for notification to appellant regarding the action  
taken; and

5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: 

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DMS:psb

Application 09/867,068

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